

Appl. No. 10/604,495  
Response Dated April 21, 2006  
Reply to Office Action Dated December 21, 2005

### REMARKS/ARGUMENTS

Please reconsider the application in view of the above amendments and the following remarks. Claims 1-56 remain in this application. Claims 2-16, 22, 36-47, 50, 51 and 54 have previously been withdrawn from consideration.

#### Amendments to Claims

Independent claims 1, 23 and 52 have been amended to clarify the invention recited. No new matter has been introduced by these amendments.

#### Rejection(s) under 35 U.S.C § 102

1. Claims 23-24, 26-28, 34, 48, 49, 52, 53, 55 and 56 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,692,565 ("MacDougall"). Claims 23 and 52 have been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Amended claim 23 recites a method for reducing debris in a perforation in a wellbore, wherein the perforation extends from the wellbore into a subterranean formation. The method comprises: positioning a downhole tool in the wellbore, the downhole tool having a bit extendable therefrom; using a flexible shaft to position and release the bit in the perforation to block debris as formation fluid flows from the perforation into the downhole tool whereby contamination is reduced in the formation fluid collected in the downhole tool. Claim 52 has similar limitations.

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To anticipate a claim, the cited reference must disclose each and every limitation of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully asserts that MacDougall cannot anticipate claim 23 and 52 because MacDougall fails to teach at least one limitation of the amended claims 23 and 52, i.e., using a flexible shaft to position and release the bit in the perforation.

MacDougall discloses methods for drilling a perforation, testing formation fluids, and plugging perforations. The bit in a tool of MacDougall is for drilling a perforation through the casing, cement, and formation. The bit in MacDougall is not releasable, as acknowledged by the Examiner in an earlier Office Action. Therefore, claims 23 and 52, as amended, are patentable over MacDougall. Claims 24, 26-28, 34, 48, 49, 53, 55 and 56 depend, directly or indirectly, from claim 23 or 52, and, therefore, these claims are also patentable over MacDougall for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

2. Claims 23-24, 26, 27, 29 and 34 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,276,453 ("Bond"). Claim 23 has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Bond discloses methods and apparatus for forcing an object through the sidewall of a borehole, using a percussive assembly. The percussive assembly comprises a reciprocating shaft having a downhole percussive end and is capable of imparting a percussive force. (Col. 1, lines 40-49). The reciprocating shaft cannot be a flexible shaft; otherwise, it cannot transmit the percussive force.

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Bond fails to teach at least one limitation of the amended claim 23. Therefore, the amended claim 23 is patentable over Bond. Claims 24, 26, 27, 29 and 34 depend, directly or indirectly, from claim 23, and, therefore, these claims are also patentable over Bond for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

3. Claims 23-24, 29, 35, 48-49, 52 and 55-56 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,164,126 ("Ciglenec"). Claims 23 and 52 have been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Ciglenec discloses methods and apparatus for measuring a property of a subsurface formation intersected by a wellbore, using a probe that is adapted for substantially producing a seal at the wall of the wellbore. The probe has means therein for measuring the property of the formation engaged by the probe. (Abstract). Ciglenec is silent with respect to a flexible shaft or positioning a bit or debris blocker in a perforation.

Because Ciglenec fails to teach at least one limitation of the amended claim 23 or 52, the amended claims 23 and 52 are patentable over Ciglenec. Claims 24, 29, 35, 48-49 and 55-56 depend, directly or indirectly, from claim 23 or 52, and, therefore, these claims are also patentable over Ciglenec for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

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**Rejection(s) under 35 U.S.C § 103**

4. Claims 1, 18, 20, 21, 52 and 53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bond. Claims 1 and 52 have been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Amended claim 1 recites a downhole tool for reducing debris in a perforation in a wellbore, wherein the perforation extends from the wellbore into a subterranean formation. The tool comprises: a housing positionable in the wellbore; and an arm in the housing and extendable therefrom, wherein the arm comprises a flexible shaft; and at least one debris blocker in the housing, the at least one debris blocker positionable in the perforation via the arm and releasable therein such that when released and positioned in the perforation, the at least one debris blocker prevents debris from flowing through the perforation and into the housing with a formation fluid whereby the contamination in the formation fluid is reduced. Amended claim 52 includes similar limitations.

Applicant respectfully asserts that the amended claims 1 and 52 are not obvious over Bond. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

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As noted above, Bond fails to teach or suggest a flexible shaft that is used to position a bit or debris blocker in a perforation. Because Bond fails to teach or suggest at least one limitation of the amended claims 1 and 52, these claims are patentable over Bond. Claims 18, 20, 21, and 53 depend, directly or indirectly, from claim 1 or 52, and, therefore, are also patentable over Bond for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

5. Claims 1 and 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall in view of Bond. Claim 1 has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As noted above, amended claim 1 requires a debris blocker that is positionable and releasable via a flexible arm, and when released and positioned in the perforation, the debris blocker can prevent debris from flowing into the tool with formation fluids.

The Examiner concedes that MacDougall fails to teach a debris blocker that is releasable. (Office Action, p. 7, lines 6-7). The Examiner relies on Bond to provide teaching of releasable features and asserts that "it would be obvious to one of ordinary skill in the art at the time of the invention to modify the debris blocker disclosed by MacDougall to be releasable as taught by Bond." (Office Action, p. 7, lines 10-12).

As noted above, MacDougall teaches a perforation device attached to a flexible shaft and a device for plugging and resealing the perforation with a solid plug. (Abstract). MacDougall teaches drilling a perforation for formation testing and resealing the perforation with solid plugs

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when the perforation is no longer needed. There is no teaching of a debris blocker that can prevent debris from flowing into the tool, while allowing formation fluid to flow into the tool.

Applicant respectfully submits that MacDougall and Bond are not properly combinable. To properly support a proffered combination of references, a patent examiner "must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them" in the proffered manner. *In re Rouffet*, 149 F.3d at 1359. Close adherence to this rigid methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Dembiczak*, 175 F.3d at 999 (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)). The Applicant submits that there is insufficient support for the proffered combinations.

MacDougall teaches using a flexible shaft to drill a perforation and to plug a perforation when no longer needed. Bond teaches the use of a percussive assembly to force a device into a perforation in a non-drilling manner. There is no teaching in either MacDougall or Bond that it would be desirable to combine the two teachings. Applicant respectfully submits that one of ordinary skill in the art would not be motivated to combine MacDougall with Bond. If the Examiner is relying upon her personal knowledge, Applicant respectfully requests that the Examiner provides an affidavit, pursuant to 37 C.R.F. § 1.104(d)(2).

Furthermore, even assuming *arguendo* that MacDougall and Bond are properly combinable, a combination of MacDougall and Bond still fail to teach or suggest a debris blocker



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that is releasable and positionable in a perforation such that debris is prevented from flowing into a tool, while formation fluids are allowed to flow into the tool.

For at least these reasons, the Applicant submits that the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. § 103. Applicant, therefore, respectfully requests reconsideration and withdrawal of the claim rejections.

6. Claim 17 stands rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall in view of Bond, and further in view of Brieger 3.934,468. Claim 1, from which claim 17 depends, has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claim 17, the rejection is respectfully traversed.

As noted above, a combination of MacDougall and Bond cannot render the amended claim 1 obvious. Brieger does not provide that which is missing from MacDougall and Bond, as evidenced by the fact that the Examiner relies upon Brieger only for the teaching of testing in uncased wellbores.

Therefore, MacDougall, Bond, and Brieger, whether considered separately or in combination, cannot render amended claim 1 obvious. Claim 17, which depends from claim 1, is therefore patentable over a combination of MacDougall, Bond, and Brieger. Accordingly, withdrawal of this rejection is respectfully requested.

7. Claims 17 and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bond in view of Brieger 3.934,468. Claims 1 and 23, from which claims 17 and 35 depend, have been

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amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As noted above, Bond fails to teach a debris blocker positionable and releasable via a flexible shaft or a method of positioning and releasing a debris blocker in a perforation. Brieger fails to provide that which is missing in Bond, as evidenced by the fact that the Examiner relies upon Brieger only for the teaching of testing uncased wellbores.

Therefore, Bond and Brieger, whether considered separately or in combination, cannot render amended claims 1 and 23 obvious. Claims 17 and 35, which depend from claims 1 and 23, respectively, are therefore patentable over a combination of Bond and Brieger. Accordingly, withdrawal of this rejection is respectfully requested.

8. Claims 25, 28, and 48-49 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bond in view of MacDougall. Claim 23, from which claims 25, 28, and 48-49 depend, has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As noted above, MacDougall and Bond are not properly combinable. Even assuming *arguendo* that MacDougall and Bond are properly combinable, they still fail to teach "using a flexible shaft to position and release a bit in the perforation," as required by the amended claim 23. Therefore, dependent claims 25, 28, and 48-49 are patentable over MacDougall and Bond for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.



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9. Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall in view of Taggart 3,430,711 ("Taggart"). Claim 23, from which claim 29 depends, has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claim, the rejection is respectfully traversed.

As noted above, MacDougall cannot render the amended claim 23 obvious. Taggart does not provide that which is missing from MacDougall, as evidenced by the fact that the Examiner relies upon Taggart for teaching the additional limitation of claim 29, i.e., positioning a filter in a perforation.

Therefore, MacDougall and Taggart, whether considered separately or in combination, cannot render amended claim 23 obvious. Claim 29, which depends from claim 23, is therefore patentable over a combination of MacDougall and Taggart. Accordingly, withdrawal of this rejection is respectfully requested.

10. Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall in view of Taggart 3,430,711 ("Taggart"), and further in view of Burnside 3,730,268 ("Burnside"). Claim 23, from which claim 30 indirectly depends, has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claim, the rejection is respectfully traversed.

As noted above, MacDougall cannot render the amended claim 23 obvious. Taggart does not provide that which is missing from MacDougall. Burnside also fails to teach or suggest that which is missing in MacDougall and Taggart, as evidenced by the fact that the Examiner relies upon Burnside for teaching drilling through a filter when a filter is no longer needed.

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Therefore, MacDougall, Taggart, and Burnside, whether considered separately or in combination, cannot render amended claim 23 obvious. Claim 30, which depends from claim 23, is therefore patentable over a combination of MacDougall, Taggart, and Burnside. Accordingly, withdrawal of this rejection is respectfully requested.

11. Claim 31-32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bond in view of Urbanosky 3,924,463 ("Urbanosky"). Claim 23, from which claims 31-32 depend, has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As noted above, Bond cannot render the amended claim 23 obvious. Urbanosky does not provide that which is missing from MacDougall, as evidenced by the fact that the Examiner relies upon Urbanosky for teaching stacking filters to further filter smaller particles.

Therefore, Bond and Urbanosky, whether considered separately or in combination, cannot render amended claim 23 obvious. Claims 31-32, which depend from claim 23, are therefore patentable over a combination of Bond and Urbanosky. Accordingly, withdrawal of this rejection is respectfully requested.

12. Claims 31 and 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bond in view of Allen et al. 3,177,955 ("Allen"). Claim 23, from which claims 31 and 33 depend, has been amended to clarify the invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

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As noted above, Bond cannot render the amended claim 23 obvious. Allen does not provide that which is missing from Bond, as evidenced by the fact that the Examiner relies upon Allen for teaching of stacking filters linearly in a perforation.


Therefore, Bond and Allen, whether considered separately or in combination, cannot render amended claim 23 obvious. Claims 31 and 33, which depend from claim 23, are therefore patentable over a combination of Bond and Allen. Accordingly, withdrawal of this rejection is respectfully requested.

#### Conclusion

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. Accordingly, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If this belief is incorrect, or other issues arise, please do not hesitate to contact the undersigned at the telephone number listed below.

Date: 21-Apr-06

Respectfully submitted,

  
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